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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,550	08/31/2006	Hiddenobu Mikami	1007-034	8917
7590 James V Costigan Hedman and Costigan 1185 Avenue of the Americas New York, NY 10036-2646			EXAMINER OLADAPO, TAIWO	
			ART UNIT 1797	PAPER NUMBER
			MAIL DATE 09/03/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/587,550

Applicant(s)

MIKAMI, HIDENOBU

Examiner

TAIWO OLADAPO

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 7, 23, 24 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 7, 23, 24 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/10/2009 has been entered.
2. The amendment dated 5/11/2009 has been considered and entered for the record. The amendment overcomes the rejections of previous claims which are hereby withdrawn. New rejections are set forth below.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
6. Claims 1, 4, 23, 24, 26, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kazuo et al. (JP 59-081394) in view of Tiffany et al. (US 5,962,378).
7. In regards to claims 1, 4, 23, 24, 26, Kazuo teaches a lubricating grease for press working comprising a mineral oil and bismuth oxide which is an inorganic bismuth compound (Derwent Abstract). Kazuo does not teach the viscosity of the base oil.

Tiffany is added to teach metal working lubricants such as grease compositions similar to Kazuo (column 11 lines 16 – 20). Tiffany teaches the basestock can be natural or synthetic oils having viscosity of from 5 to 10,000 mm²/s at 40°C which overlaps the claimed range (column 13 lines 32 – 38). Tiffany teaches base oils can be synthetic oils such as ether oils and polyalphaolefins (column 14 lines 1 – 10; 43 – 46).

In the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have prepared lubricating greases for press working according to the invention of Kazuo using the lubricating oil of Tiffany, as Tiffany teaches lubricating oils suitable for preparing metal working greases.

8. In regards to claim 2, Kazuo and Tiffany combined teach the composition. Kazuo teaches that the grease comprises base materials consisting of 20 – 50% sulfurized oil and 1 - 10% asphalt with the rest of 40 - 79% as solids, or 20 – 50% sulfurized oil and 20 – 50% organomolybdenum compound with the rest of 0 to 40% as solids. Kazuo teaches the solids can comprise bismuth oxides which therefore overlaps the claimed percentage of inorganic bismuth compound.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kazuo et al. (JP 59-081394) in view of Tiffany et al. (US 5,962,378) and further in view of Yamamoto et al. (US 4,256,591)

10. In regards to claim 7, Kazuo and Tiffany combined teach the lubricant but do not particularly recite the thickeners of the claim. Yamamoto is added to teach metal working lubricating grease similar to Kazuo and Tiffany combined (abstract). Yamamoto teaches that the thickeners can include lithium soaps and polyurea thickeners which meets the claimed limitation. It would have been obvious for one of ordinary skill in the art at the time of the invention to have used the thickeners recited by Yamamoto in the combined invention of Kazuo and Tiffany, as Yamamoto teaches thickeners suitable for preparing metal working greases.

Response to Arguments

11. The applicant argues that amendment removes ester based basecoils from claim 1, thus overcoming the reference by Willey. However, new rejections are made over the references of Kazuo, Tiffany and Yamamoto, therefore, the argument is moot.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAIWO OLADAPO whose telephone number is (571)270-3723. The examiner can normally be reached on 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Glenn A Caldarola/
Acting SPE of Art Unit 1797

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